



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,524	09/30/1999	EUGENE M. LEE	K7565.0001/P001	5499

24395 7590 04/07/2004

HALE & DORR LLP
THE WILLARD OFFICE BUILDING
1455 PENNSYLVANIA AVE, NW
WASHINGTON, DC 20004

EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/409,524

Applicant(s)

LEE, EUGENE M.

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2002 and 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. **The rejection of Claims 1-57** under 35 U.S.C. 103(a) as being unpatentable over InventNet.com (www.inventnet.com, 11/7/1996), in view of The World Intellectual Property Organization (PCT-Easy, User Reference Manual, January 1999, <http://pcteasy.Iwai.int/en/index.html>) is withdrawn due to applicant's arguments.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. **Claims 1-3, 5-8, 10-12, 14-16, 20-22, 24-34, 37, 38, 40-48, and 50-57** are rejected under 35 U.S.C. 103(a) as being unpatentable over InventNet.com (www.inventnet.com, retrieved from Internet Archive WayBack Machine <www.archive.org>, date range: 12/3/1998-2/9/1999), in view of IWAI et al. (US 5,175,681).
4. As per independent Claims 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 and 56, InventNet.com discloses a method of operating an information service (information system, one-stop intellectual property filing service, a computer implemented method, and/or an intellectual property filing preparation system) to facilitate preparation of intellectual property documents suitable for filing in one or more of plural target jurisdictions the

method comprising (pgs. 1-6): registering for each of plural associates (pgs.7-9, Patent Attorney Directory), at least one target jurisdiction (pg.7, US area codes, Australia, Caribbean, etc.) and a computer readable encoding of a plurality of form documents (pg.10). (www.inventnet.com).

5. InventNet.com fails to expressly disclose wherein the form documents are corresponding to target jurisdiction and associate specifications; and distributing at least a portion of the form documents to an originating filer for use in preparation of the intellectual property documents suitable for filing by respective ones of the associates.
6. However InventNet.com does disclose providing form documents necessary for preparing and filing intellectual property (available for download, pg.1 and 10), and official notice is given that all necessary form documents were available electronically at the time the invention was made through various websites (www.uspto.gov, www.epo.co).
7. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to correlate specific forms with associates (attorneys) as required for filing the application, for the advantage of offering an intellectual property information service with the ability to provide the user with all necessary/required tools to efficiently complete an intellectual property application filing.
8. Furthermore, IWAI discloses a computerized system used to facilitate the preparation of intellectual property applications for filing in various countries (jurisdictions) (Abstract, C1 L28-45, C3 L21-67).
9. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein distributing at least a portion of the form

documents to an originating filer for use in preparation of the intellectual property documents suitable for filing by respective ones of the associates, as disclosed by IWAI in the system disclosed by InventNet.com, for the advantage of operating an information service to facilitate preparation of intellectual property documents with the ability to increase the efficiency/effectiveness of the system by providing the user with automated tools to complete a number of intellectual property application filings.

10. As per Claim 2, InventNet.com and Iwai disclose wherein the distribution is responsive to selection by the originating filer of one or more of the target jurisdictions and, for each selected target jurisdiction, a respective one of the associates.
11. As per Claim 3, InventNet.com and IWAI disclose wherein the distribution includes periodic supply to the originating filer of computer readable encoding of at least a portion of the form documents for each of plural associates.
12. As per Claim 6, InventNet.com and IWAI disclose wherein the selection at the originating node includes selection of two or more target jurisdictions.
13. As per Claim 7, InventNet.com and IWAI disclose wherein for each selected at least one target jurisdiction and corresponding at least one associate, the particularized requirements include: formatting requirements for filing of the intellectual property filing in the target jurisdiction; and an encoding of at least one filing suitable for filing at target jurisdiction.
14. As per Claim 8, InventNet.com and IWAI disclose wherein for each selected at least one target jurisdiction and corresponding at least one associate, the particularized requirements include: information characterizing one or more data fields for which values

specific to the intellectual property filing are to be supplied from the originating node to allow preparation of documents for filing in the selected at least one target jurisdiction by the selected at least one associate.

15. As per Claim 10, InventNet.com and IWAI disclose wherein the originating node includes a computer of a managing attorney or intellectual property owner; and wherein at least a portion of the target nodes include a computer of a respective associate configured to electronically receive at least a portion of the intellectual property filing from the originating node via the intellectual property filing portal.
16. As per Claim 11, InventNet.com and IWAI disclose wherein the originating node includes a web browser; wherein the intellectual property filing portal includes a web server; and wherein the selection of at least one target jurisdiction and at least one associate, the supplying of the particularized requirements, and the receipt of the one or more intellectual property filings prepared in accordance with the particularized requirements are achieved, at least in part, using internet protocol traffic between the web browser and the web server.
17. As per Claim 12, InventNet.com and IWAI disclose wherein the intellectual property filing portal is further responsive to registration by one or more of the associates of particularized requirements for the corresponding at least one target jurisdiction; wherein the supplied particularized requirements include those registered by the selected at least one associates.
18. As per Claim 14, InventNet.com and IWAI disclose wherein the received intellectual property filings include one or more of: a computer readable encoding of a technical

document including specification and claims formatted in accordance with the supplied particularized requirements of at least a first of the selected target jurisdictions; and a computer readable encoding of information for completion of a filing paper, request for examination or transmittal in accordance with the supplied particularized requirements of the first selected target jurisdiction and the selected associate therefore.

19. As per Claim 16, InventNet.com and IWAI disclose registering one or more associates

for the making of intellectual property filing in respective one or more target jurisdictions, the registering including updating a data store with computer readable encodings of one or more form documents specific to at least one associate and the respective at least one target jurisdiction.

20. As per Claim 20, InventNet.com and IWAI disclose responsive to the selection by the

user of the at least one target jurisdiction and the at least one associate corresponding thereto, retrieving a computer readable encoding of target jurisdiction filing requirements for technical documents; and preparing one or more technical documents of the one or more documents suitable for filing in accordance with the target jurisdiction filing requirements for technical documents.

21. As per Claim 21, InventNet.com and IWAI disclose supplying the user, via the network,

with the computer readable encoding of target jurisdiction filing requirements for technical documents; and performing the preparing at the user's site using the computer readable encoding of target jurisdiction filing requirements; and receiving from the user, via the network, the prepared one or more technical documents for forwarding to the selected at least one associate.

22. As per Claim 24, InventNet.com and IWAI disclose populating the one or more target jurisdiction and associate-specific documents with matter specific information.
23. As per Claim 26, InventNet.com and IWAI disclose for each selected target jurisdiction: completing the one or more form documents in accordance with matter specific information retrieved from a data store.
24. As per Claim 27, InventNet.com and IWAI disclose selecting the respective associate from amongst a set of supported associates.
25. As per Claims 28-30, InventNet.com and IWAI disclose wherein the obtaining is from an intellectual property filing portal; and wherein the supplying for transfer includes supplying a computer readable encoding to the intellectual property filing portal for forwarding to the respective associate.
26. As per Claim 31, InventNet.com and IWAI disclose wherein the obtaining and the supplying are via a network; and wherein the supplied portion of the set of filing documents includes at least a computer readable encoding of one or more technical documents.
27. As per Claim 32, InventNet.com and IWAI disclose wherein the supplied portion of the set of filing documents includes one or more technical documents and completed ones of the one or more form documents.
28. As per Claim 34, InventNet.com and IWAI disclose wherein the transforming is further in accordance with a computer readable encoding if the selected attorney or agent's requirements.

29. As per Claim 37, InventNet.com and IWAI disclose wherein the electronically transmitting is via an information service intermediary; and further comprising receiving from the information service intermediary at least the computer readable encoding of filing requirements for the selected one or more target jurisdictions.
30. As per Claim 38, InventNet.com and IWAI disclose wherein the electronically transmitting is via an information service intermediary; and wherein the transforming is performed by the information service intermediary.
31. As per Claim 40, InventNet.com and IWAI disclose representing the intellectual property application data in a target-neutral format prior to the transforming thereof.
32. As per Claim 42, InventNet.com and IWAI disclose for each target jurisdiction selection, receiving a selection of at least one attorney and/or agent corresponding thereto, wherein the computer readable encoding of filing requirements includes attorney- and/or agent-specific requirements for at least the selected at least one attorney and/or agent.
33. As per Claim 43, InventNet.com and IWAI disclose transmitting, for at least one of the selected one or more target jurisdictions, a computer readable encoding of a technical document for filing in the selected one or more selected target jurisdiction.
34. As per Claim 45, InventNet.com and IWAI disclose a communications interface for transmitting the transformed intellectual property application data and at least one additional document for filing.
35. As per Claim 46, InventNet.com and IWAI disclose a data store, responsive to the retrieval interface, for storing the intellectual property application data.

36. As per Claim 47, InventNet.com and IWAI disclose wherein the target includes a target jurisdiction and/or convention; and wherein the target requirement data includes filing requirements for the target jurisdiction and/or convention.
37. As per Claim 48, InventNet.com and IWAI disclose wherein the target further includes an attorney and/or agent; and wherein the target requirement data further includes attorney- and/or agent-specific requirements.
38. As per Claim 50, InventNet.com and IWAI disclose wherein the target-specific intellectual property application-filing format is an electronic format for transmission to the target.
39. As per Claim 51, InventNet.com and IWAI disclose an information system embodied as a client application executable on a originating computer and implementing: the selection facility, the retrieval interface to intellectual property application data, the retrieval interface to requirement data; and the filing preparation facility and including a communications interface to a server application; and wherein at least the requirement data is hosted by the server application.
40. As per Claim 53, InventNet.com and IWAI disclose wherein the selected code, the retrieval code, the document preparation code and filing initiation code are all executable on a same processor.
41. As per Claim 55, InventNet.com and IWAI disclose registering individual one or ones of the associates for fulfillment of intellectual property filing in respective of the target jurisdictions.

42. As per Claim 57, InventNet.com and IWAI disclose wherein, the one or more target jurisdiction and associate-specific documents include one or more technical documents.
43. **Claims 9, 17, 18, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over InventNet.com, in view of IWAI et al., and further in view of Brown, Pinnisi & Michaels, PC (www.lightlink.com\bbm, retrieved from Internet Archive Wayback Machine <www.archive.org>, date range: 2/24/1998-2/18/1999).**
44. As per Claim 9, InventNet.com and IWAI fail to expressly disclose wherein for each selected at least one target jurisdiction and corresponding at least one associate, the particularized requirements include: an encoding of at least one paper required by the selected at least one associate.
45. However, BPM discloses an intellectual property information service with an encoding of at least one paper required by the selected at least one associate (pgs.7-9, Invention Disclosure Form).
46. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an encoding of at least one paper required by the selected at least one associate, as disclosed by BBM, in the system disclosed by IWAI, in the system disclosed by InventNet.com, for the advantage of operating an information service to facilitate preparation of intellectual property documents with the ability to increase the efficiency of the system by providing the users with the necessary tools/information to complete a intellectual property application filing.
47. As per Claims 17 and 23, InventNet.com and IWAI disclose fail to expressly disclose providing one or more quoted fees associated with both the at least one target jurisdiction

and the at least one associate, wherein the supplying of the computer readable encoding of one or more form documents is contingent upon authorization by the user of the quoted fees.

48. However, BPM discloses an intellectual property information service wherein the website outlines the fees associated with the application process (pgs.10-12) along with an outline of the steps required in the application process, to include an initial consultation, search, and application completion and filing (pgs. 10-12).

49. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to simple automate this process by completing the outlined steps electronically – to include an electronic consultation (wherein fees and schedules would be reviewed and agreed upon) and to further supply the necessary forms for completion of the intellectual property application process, for the advantage of increasing the efficiency and effectiveness of the system by supplying the user with a fully automated method of completing the application process.

50. As per Claim 18, InventNet.com, IWAI, and BPM disclose providing one ore more quoted fees associated with both the at least one target jurisdiction and the at least one associate substantially coincident with the selection; and transacting the quoted fees substantially coincident with the one or more of the selection, the receiving of one or more documents and the filing in the selected target jurisdiction (see rejection of Claims 17 and 23).

51. Claims 4, 13, 35, 36, 39, and 49 are rejected under 35 U.S.C. 103 as being unpatentable over InventNet.com in view of IWAI.

52. As per Claim 4, InventNet.com and IWAI fail to expressly show wherein the distribution is encoded by and/or transmitted in at least one computer readable medium selected from the set of a disk, CD-ROM, tape or other magnetic, optical, or electrical storage medium and a network, wireline, wireless or other communications medium.
53. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method of operating an information service to facilitate preparation of intellectual property documents would be performed regardless of the type of computer readable medium used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
54. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used at least one computer readable medium selected from the set of a disk, CD-ROM, tape or other magnetic, optical, or electrical storage medium and a network, wireline, wireless or other communications medium, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
55. As per Claim 13, InventNet.com and IWAI fail to expressly show wherein the network includes one or more of a packet switched network segment, a circuit switched network segment, a public network segment, a private network segment, a public switched telecommunications network segment, and a virtual private network.

56. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method of operating an information service to facilitate preparation of intellectual property documents would be performed regardless of the type of network used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
57. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a network that included one or more of a packet switched network segment, a circuit switched network segment, a public network segment, a private network segment, a public switched telecommunications network segment, and a virtual private network, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
58. As per Claims 35, 36, and 49, InventNet.com and IWAI fail to expressly show wherein the intellectual property application data includes contents of a priority application, data retrieved from a docket system, and/or priority application data content corresponding to a previously filed intellectual property application.
59. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method of operating an information service to facilitate preparation of intellectual property documents would be performed regardless of what the intellectual property application data included. Thus, this

descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

60. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used intellectual property application data that included contents of a priority application, data retrieved from a docket system, and/or priority application data content corresponding to a previously filed intellectual property application, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

61. As per Claim 39, InventNet.com and IWAI fail to expressly show wherein the one or more intellectual property related documents include at least one of an intellectual property application, an amendment, a transmittal paper, an appointment of agent, and legalization paper.

62. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method of operating an information service to facilitate preparation of intellectual property documents, would be performed regardless of the what intellectual property related documents were used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

63. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used intellectual property related documents that included at least one of an intellectual property application, an amendment, a transmittal paper, an appointment of agent, and legalization paper, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

64. Claim 19 is rejected under 35 U.S.C. 103 as being unpatentable over InventNet.com in view of IWAI, and further in view of BPM.

65. As per Claim 19, InventNet.com, IWAI, and BPM fail to expressly show wherein the transacting includes one or more of debiting a deposit account, executing a wire transfer, and electronically authorizing payment of the quoted fees using a credit card, debit card or other payment system.

66. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method of operating an information service to facilitate preparation of intellectual property documents would be performed regardless of the type of transaction used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

67. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a transaction that included one or more of debiting a deposit account, executing a wire transfer, and electronically authorizing payment of the

quoted fees using a credit card, debit card or other payment system, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

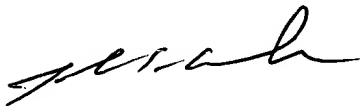
Response to Arguments

68. Applicant's arguments with respect to Claims 1-57 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

69. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Friday, 8am - 4:30pm.
70. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.
71. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

jo
March 30, 2004


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600